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In re Application of
DUBOIS

Application No.: 09/202,217

PCT No.: PCT/FR97/01023

Int. Filing Date: 10 June 1997

Priority Date: 11 June 1996

Attorney's Docket No.: 146.1307

For: TRIMEGESTONE, THEIR PREPARATION
PROCESS AND THEIR USE AS MEDICAMENTS

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DECISION ON
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PETITION UNDER
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37 CFR 1.42
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This decision is in response to the "PETITION UNDER RULE 42" filed 21 September 1999.

BACKGROUND

On 10 June 1997, applicant filed international application PCT/FR97/01023, which claimed a priority date of 11 June 1996. A copy of the international communication was communicated to the United States Patent and Trademark Office from the International Bureau on 18 December 1997. A Demand for international preliminary examination in which the United States was elected, was filed on 31 December 1997, prior to the expiration of nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 11 December 1998.

On 09 December 1998, applicant filed, in the United States Patent and Trademark Office (PTO), a transmittal letter requesting entry into the U.S. national stage, which was accompanied by, *inter alia*, the requisite U.S. basic national fee.

On 21 September 1999, applicants filed the present PETITION UNDER RULE 42. The petition is accompanied by:

- the petition fee;
 - a declaration of Jean-Claude Vieillefosse setting forth facts entitled DECLARATION UNDER RULE 47 (hereinafter "declaration of facts"); and
 - a declaration of Mr. Vieillefosse on behalf of and as agent for the non-signing inventor;
- Exhibits A-F.

Because the declaration setting forth facts is entitled DECLARATION UNDER RULE 47 and states that the inventor "has indicated that he will not execute the documents" and the declaration on behalf of the non-signing inventor states that the inventor "has refused to execute the application", it is not clear whether the inventor is deceased or whether the inventor refuses to execute the application. Note that "37 CFR 1.47 should not be considered an alternative to 37 CFR 1.42". MPEP § 409.03(c). Also, it is noted that Exhibits A and D-F are not in the application file. Additionally, the listing of "Enclosures" in the petition does not include the documents corresponding to Exhibits A and D-F.

On 27 October 1999, the United States Patent and Trademark Office (PTO) mailed applicants a NOTIFICATION OF MISSING REQUIREMENTS (PCT/DO/EO/905) and a NOTIFICATION OF A DEFECTIVE OATH OR DECLARATION (PCT/DO/EO/917) which indicated that the oath or declaration was not properly executed, and set a one month time period for response.

On 04 November 1999, applicant filed a RESPONSE to the NOTIFICATION OF MISSING REQUIREMENTS stating that a petition under Rule 42 was filed on 21 September 1999. The RESPONSE included a postcard receipt. Note that this postcard receipt does not list the items which comprise Exhibits A and D-F.

DISCUSSION

This decision will not discuss Exhibits A and D-F as they have not been provided. These documents do not appear in the file. The listing of Enclosures and the postcard receipt, both referred to above, suggest that these documents have not been sent.

I. 37 CFR 1.42

Pursuant to 37 CFR 1.42, first sentence:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Here, an oath or declaration by the legal representative of the deceased inventor has not been presented.

II. Discussion of the petition and supporting documentation as it relates to 37 CFR 1.47(b)

This discussion is for petitioner's information only. It is not an Official decision because a petition under 37 CFR 1.47(b) has not been filed.

A petition under 37 CFR 1.47(b) must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest

in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. Applicants have satisfied items (1) and (6) above.

In regard to item (5) above, applicant attempts to demonstrate sufficient proprietary interest in the application by showing that the inventor, DUBOIS, has agreed in writing to assign the invention. The following proofs are provided in support:

- Employment contract of DUBOIS (with English translation);
- Attestation of DUBOIS employment (with English translation); and
- French Law No. 92-597, Section II, Right to Title (with English translation).

MPEP § 409.03(f) states in part:

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to 37 CFR 1.47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (nonsigning inventor) agrees to assign to his or her employer (37 CFR 1.47(b) applicant) all inventions made during employment. When such an agreement is relied on, it must be established by the affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by the employee while employed by the 37 CFR 1.47(b) applicant.

Lacking such an affidavit or declaration of a person having firsthand knowledge of the facts that the invention was made by an employee while employed by the 37 CFR 1.47(b) applicant, sufficient proprietary interest in the application has not been demonstrated. Further, if a declaration for designation of inventors is relied upon, an English translation should also be provided. Further still, if the French Law Section is to be relied upon for showing proprietary interest rather than the employment contract, a legal memorandum as described in the last paragraph of MPEP 409.03(f) would be required.

As to item (4), the declaration must be made by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor. However, it is not clear from the record that Jean-Claude Vieillefosse, whose title is "Head of the Patent Department", has authority to sign the declaration on behalf of Hoechst Marion Roussel. Further, 37 CFR 1.63 requires both the inventor's place of residence and post office address to be included in the declaration.

MPEP 605.03 states in part:

In situations where an inventor does not execute the oath or declaration and the inventor is not deceased, such as in an application filed under 37 CFR 1.47, the inventor's most recent home address must be given to enable the Office to communicate directly with the inventor as necessary.

The declaration does not include DUBOIS's current place of residence or home address. It purports to list merely a former place of residence and address of DUBOIS (17 rue Anatole France, 91120 Palaiseau, France), and the address of his current employer, Sanofi Recherche (371 rue du Professeur Blayac, 34000 Montpellier, France).

As to item (3), it is not clear from the submission which stated address is the last known address of the inventor. As stated above, the declaration lists a former place of residence and address of DUBOIS (17 rue Anatole France, 91120 Palaiseau, France), and the address of his

current employer Sanofi Recherche, (371 rue du Professeur Blayac, 34000 Montpellier, France). These two addresses also appear throughout the other submitted documentation and correspondences. A further address (63 rue de Meauz, 75019 Paris, France) is listed as the residence of DUBOIS on the Attestation of employment prepared by Jocelyne Saulquin on 28 April 1999, and was the address used in the correspondence from Manuela Louvet to DUBOIS dated 9 November 1998. Clarification as to the last known address of DUBOIS is required.

As to item (2), petitioner contends that DUBOIS refuses to execute the application. MPEP § 409.03(d) states in part:

The affidavit or declaration of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as certified mail return receipt, cover letter of instructions, telegrams, etc., that support a finding that the nonsigning inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

Here, the declaration of facts is not signed by a person having firsthand knowledge of the facts recited therein. On page 3 of the declaration of facts by Jean-Claude Vieillefosse, Mr. Vieillefosse states that "Mr. Dubois has indicated that he will not execute the documents." However, it is not clear if this was an express refusal, either written or oral, or if Mr. Vieillefosse has concluded that the conduct of Mr. Dubois constitutes a refusal. Lacking any further explanation or documentation, refusal on the part of DUBOIS will not be presumed, and has not been adequately demonstrated.

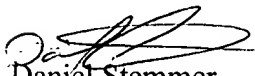
CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.42 is **DISMISSED**, without prejudice.

The discussion of the petition and supporting documentation as it relates to 37 CFR 1.47(b) is for petitioner's information only and does not constitute an Official decision.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.42" or "Petition Under 37 CFR 1.47(b)", whichever is appropriate. No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, Box PCT, Washington, D.C. 20231, with the contents of this letter marked to the attention of the PCT Legal Office.



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